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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/750,374	12/31/2003	Patrick W. Smith	101.00011	4893

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EXAMINER

KITOV, ZEEV V

ART UNIT PAPER NUMBER

2836

DATE MAILED: 11/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/750,374

Applicant(s)

SMITH ET AL.

Examiner

Zeev Kitov

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 5 - 8, 19 - 41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 5 - 8, 19 - 23, 26 - 38, 41 is/are rejected.
- 7) ☒ Claim(s) 24, 26, 39 and 40 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>11/01/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Examiner acknowledges a submission of the amendment and arguments filed on November 1, 2006. Claims 9 – 18 are deleted; Claim 1 is amended. New Claims 19 – 41 are added.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 6 – 8, 19 – 21, 26 – 28, 31 – 35, 36 and 41 are rejected under 35 U.S.C. 102(b) as being anticipated by Ragner (5,698,815). Regarding Claims 1, Ragner discloses an electronic disabling device implementing a step of providing the stimulus signal in accordance with a strike stage, i.e. pulses with a voltage lower than 1000 V (Fig. 4, col. 12, lines 5 – 18 and col. 4, lines 61 – 65); a step of providing the stimulus signal in accordance with a hold stage, i.e. few defibrillation pulses (Fig. 4, col. 12, lines 18 – 25), and a step of providing the stimulus signal in accordance with a rest stage, i.e. providing no stimulus. According to Specification [0056], the rest stage may include no stimulus signal. As to results of the electrical shock, Ragner uses the term, “stun shock” (see Ragner’s Abstract), the word “shock” is defined in the American Heritage Dictionary as to daze or render senseless, by or as if by a blow. Therefore, when the

target is overwhelmed by a neural shock it is incapacitated, i.e. being senseless the target is unable to conduct voluntary locomotion.

Regarding Claim 2, Ragner discloses the strike stage having a first repetition rate of 12 pulses per second (Fig. 4, col. 12, lines 26 – 33) and the second repetition rate is lower than the first repetition rate (shown in Fig. 4).

Regarding Claims 6 and 7, Ragner discloses the stimulus signal during the strike stage having a peak voltage lower than 1000 volts (col. 4, lines 57 – 65), repetition rate of 12 pulses per second (Fig. 4, col. 12, lines 26 – 33) and delivering a charge in the range from 0 to 500 micro-coulombs (col. 4, lines 57 – 65).

Regarding Claim 8, Ragner discloses reversing the polarity of consecutive pulses in the series (shown in Fig. 4).

Regarding Claims 19 and 34, Ragner discloses the stimulus delivered to the target during the strike by penetrating needles (shown in Fig. 2), i.e. without a gap.

Regarding Claims 20 and 35, Ragner discloses a step for coupling the stimulus signal to the target, i.e. needle electrode penetration through the skin.

Regarding Claims 21 and 36, Ragner discloses launching wire-tethered electrodes toward the target (shown in Fig. 3).

Regarding Claims 26 and 41, Ragner discloses the stimulus signal (shown in Fig. 4), which during the rest stage (after 5 seconds) permits the target to breath; evidence for that is (a) a lack of further stimulation and (b) defibrillating pulses (114 and 116 in Fig. 4) are used to stop the target's heart from fibrillating (should it occur). It is

clear therefore, that in such conditions the target is either able to breath, or if not then defibrillating pulses help him to regain ability to breath.

As per Claim 27, it differs from Claim 1 rejected above by its limitation of providing the stimulus signal in accordance with a hold stage and a rest stage. Ragner discloses providing the stimulus signal including all three stages, the strike stage (112 in Fig. 4) the hold stage (between 5 and 20 seconds in Fig. 4) when the target is recuperating from the shock obtained in the strike stage and the rest stage (after 20 seconds in Fig. 4).

Regarding Claim 28, Ragner discloses the stimulus signal during strike stage (first 5 seconds in Fig. 4) having a first repetition rate (30 pulses per second) and stimulus during the hold stage (from 5 to 20 seconds in Fig. 4) having the second repetition rate (one pulse per 10 seconds), which is less than the first repetition rate.

Regarding Claim 31, Ragner discloses providing the stimulus signal in a strike stage having a pulse repetition rate of 30 pulses per second

Regarding Claims 31 - 32, Ragner discloses the stimulus signal during the strike stage having a repetition rate of 12 pulses per second (Fig. 4, col. 12, lines 26 – 33) and delivering a charge in the range from 0 to 500 micro-coulombs (col. 4, lines 57 – 65).

Regarding Claim 33, Ragner discloses reversing the polarity of consecutive pulses (Fig. 4, see Abstract).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5, 23, 29, 30 and 38 are rejected under 35 U.S.C. 103(a) as being obvious over Ragner in view of Watkins et al. (US 6,999,295).

The applied reference has a common inventor with the instant application, Nerheim. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(I)(1) and § 706.02(I)(2).

Regarding Claims 5, 23, 30 and 38, Watkins et al. disclose a step providing a path formation stage with stimulus signal provided only after the path formation stage, i.e. in accordance with whether the path formation preceded the strike stage (col. 5, line 40 – col. 6, line 39). The reference has the same problem solving area, namely providing apparatus for the immobilization of a living target. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the Ragner solution by providing the path formation stage according to method of Watkins et al., because as Watkins et al. state (col. 3, lines 15 – 27), adding the path formation stage helps to substantially reduce the stimulation voltage, thus making the stun gun much less dangerous and improve the stun gun design by reducing the size of the capacitors and the batteries.

Regarding Claims 29, Watkins et al. disclose the stimulus signal during the strike stage including a first pulse delivering a first charge to the target and a second pulse delivering the second charge that is less than the first charge (Fig. 4B, col. (col. 5, line 40 – col. 6, line 39). A motivation for modification of the primary reference is the same as above.

Claim 22 is rejected under 35 U.S.C. 103(a) as being obvious over Ragner in view of Carman (US 6,880,466). Claim 22 differs from Claim 20 rejected above by its limitation of wireless projectile. Carman discloses the stun gun with wireless projectiles (Fig. 1, col. 5, line 52 – col. 6, line 37). The reference has the same problem solving area, namely providing a stun gun for restraining the living target. It would have been

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obvious to one of ordinary skill in the art at the time the invention was made to have modified the Ragner solution by making the projectile wireless according to teachings of Carman, because as Carman states (col. 1, line 47 – col. 2, line 60), the wireless projectile has an advantage of increased hitting range and the non-lethal weapon much less complex in use.

Claim 37 is rejected under 35 U.S.C. 103(a) as being obvious over Ragner in view of Watkins et al. and Carman. Claim 37 differs from Claims 35 and 27 rejected above by its limitation of wireless projectile. Carman discloses the stun gun with wireless projectiles (Fig. 1, col. 5, line 52 – col. 6, line 37). The reference has the same problem solving area, namely providing a stun gun for restraining the living target. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the Ragner solution by making the projectile wireless according to teachings of Carman, because as Carman states (col. 1, line 47 – col. 2, line 60), the wireless projectile has an advantage of increased hitting range and the non-lethal weapon much less complex in use.

Allowable Subject Matter

Claims 24, 25, 39 and 40 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's Arguments have been given careful consideration but some of them are now moot in view of different basis for rejection, while others have been found non-persuasive.

1. The Affidavit supplied by Applicant under 37 CFR 1.132 presents an opinion, which is not substantiated by any evidence of the record. The affidavit attempts to disqualify the Ragner reference by alleging its inoperability. However, it presented no evidence to support the author's conclusion.

According to MPEP 716.07: Since every patent is presumed valid (35 U.S.C. 282), and since that presumption includes the presumption of operability (*Metropolitan Eng. Co. v. Coe*, 78 F.2d 199, 25 USPQ 216 (D.C.Cir. 1935), examiners should not express any opinion on the operability of a patent. Affidavits or declarations attacking the operability of a patent cited as a reference must rebut the presumption of operability by a preponderance of the evidence. *In re Sasse*, 629 F.2d 675, 207 USPQ 107 (CCPA 1980).

Further, since in a patent it is presumed that a process if used by one skilled in the art will produce the product or result described therein, such presumption is not overcome by a mere showing that it is possible to operate within the disclosure without obtaining the alleged product. *In re Weber*, 405 F.2d 1403, 160 USPQ 549 (CCPA 1969). It is to be presumed also that skilled workers would as a matter of course, if they do not immediately obtain desired results, make certain experiments and adaptations, within the skill of the competent worker. The failures of experimenters who have no interest in succeeding should not be accorded great weight. *In re Michalek*, 162 F.2d

229, 74 USPQ 107 (CCPA 1947); *In re Reid*, 179 F.2d 998, 84 USPQ 478 (CCPA 1950).

2. Applicant attacks the operability of the Ragner reference citing the affidavit opinion (see above) and alleging that the signal from device with the electrodes spaced apart by 3 cm cannot “interfere with voluntary control of the targets skeletal muscles so as to halt voluntary locomotion by the target” (page 8). It further alleges that Ragner does not teach: “a strike stage that causes contraction in the skeletal muscles of the target and halts voluntary locomotion by the target”. The argument is unpersuasive due to following reasons.

(a) Ragner reference uses variety of embodiments, some of them like for example, shown in Fig. 1, 2 and 6 demonstrate the inter-electrode distance substantially larger than 3 cm (col. 11, lines 35 – 56).

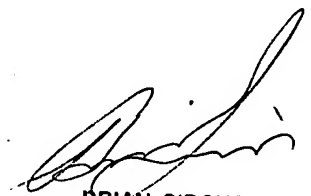
(b) There is no evidence that 3 cm separation would not incapacitate some targets. The device need not incapacitate everyone, only someone.

(c) Ragner uses the term “incapacitate”, which according American Heritage Dictionary, is to deprive of strength or ability; disable. The word “incapacitation”, as often used in stun gun technology describes as preventing any activity, i.e. preventing voluntary locomotion. Ragner discloses long-term incapacitation (see Abstract). Additionally, Ragner uses an alternative term, “stun shock” (see Abstract), which is a result described in the American Heritage Dictionary as to daze or render senseless, by or as if by a blow. Therefore, when the target is overwhelmed by a neural shock it is incapacitated, i.e. unable to conduct voluntary locomotion.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zeev Kitov whose current telephone number is (571) 272 - 2052. The examiner can normally be reached on 8:00 – 4:30. If attempts to reach examiner by telephone are unsuccessful, the examiner's supervisor, Brian Sircus can be reached on (571) 272 – 2800, Ext. 36. The fax phone number for organization where this application or proceedings is assigned is (571) 273-8300 for all communications.

Z.K.
11/26/2006



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